

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Reissue Application of:

URANO et al.

U.S. Patent No. **5,216,135**

Issue Date: **June 1, 1993**

For: **DIAZODISULFONES**

PRELIMINARY AMENDMENT

Director of Patents and Trademarks
Washington, D.C. 20231

March 15, 2001

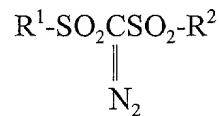
Sir:

Prior to calculation of the filing fee and examination of this reissue application, please amend the reissue application as follows:

IN THE CLAIMS:

Please cancel claims 1-6 and amend claim 7 as follows:

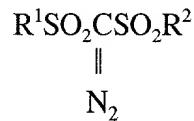
7. (Amended) A diazodisulfone compound of the formula:



wherein R^1 is a branched alkyl group having 3 to 8 carbon atoms; and R^2 is a cyclic alkyl group having 3 to 8 carbon atoms.

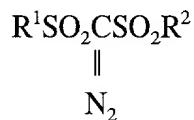
Please add new claims 8 and 9 as follows:

8. A diazodisulfone compound of the formula;



wherein R¹ is a cyclic alkyl group in which the alkyl group is hexyl; and R² is a cyclic alkyl group in which the alkyl group is hexyl.

9. A diazodisulfone compound of the formula;



where R¹ is a branched alkyl group in which the alkyl group is butyl; and R² is a branched alkyl group in which the alkyl group is butyl.

REMARKS

Claims 7 and new claims 8 and 9 are pending in this application.

An adverse decision from the United States Court of Appeals for the Federal Circuit, *In re Wako Pure Chemical Industries Ltd.*, No. 00-1139 (Fed. Cir. February 1, 2001), an appeal from *Ex parte Wako Pure Chemical Industries Ltd.*, No. 1999-1971 (Bd. Pat. App. Int'f September 24, 1999) of reexamination No. 90/004,812, warrants the cancellation of claims 1-6. In reexamination the Board sustained the Examiner's rejection of claims 1 and 4-6 under 35 USC § 102(e) and 103(a) over US Patent No. 5,338,641 to **Pawlowski et al.** Claims 2-3 were also

rejected and not appealed.

Claim 7, still in force, has been amended to be in independent form.

New claims 8 and 9 are supported in the reissue specification as follows (col 2, lines 32-

48:

In the formula (I), the alkyl group in the definition of R¹ includes, for example, an isopropyl group, an isobutyl group, a sec-butyl group, a tert-butyl group, an isoamyl group, a sec-amyl group, a 2-methylbutyl group, a 2-methyl-2-butyl group, a 1,1-dimethylbutyl group, a 2-hexyl group, a 1,1-dimethylpentyl group, a 1,1-dimethylhexyl group, a cyclopropyl group, a cyclopentyl group, a cyclohexyl group, a cycloheptyl group, a cyclooctyl group, etc. The alkyl group in the definition of R² includes, for example, a methyl group, an ethyl group, a n-propyl group, an isopropyl group, a cyclopropyl group, a n-butyl group, an isobutyl group, a sec-butyl group, a tert-butyl group, an n-amyl group, an isoamyl group, a sec-amyl group, a 2-methylbutyl group, a 2-methyl-2-butyl group, a cyclopentyl group, a n-hexyl group, a cyclohexyl group, a n-heptyl group, a n-octyl group, etc. (emphasis added).

The recitation of a n-butyl group, an isobutyl group, a sec-butyl group, a tert-butyl group is a recitation of all possible configurations of a branched butyl configuration.

New claims 8 and 9 are supported in the priority document of the reissue specification as follows (certified translation, p.14, lines 5-10.)

In the photosensitive compound represented by the formula [I] of this invention, as the straight-chain, branched or cyclic alkyl group or the alkyl group in the haloalkyl group represented by R¹, and R², there are included C₁₋₁₀ alkyl groups such as methyl, ethyl, propyl, butyl, amyl, hexyl, octyl, and decyl group. (Emphasis added).

The new claims are of narrower scope than the original claims and are fully supported in the reissue specification and the priority document dated January 30, 1990. Because of the priority date, claim 7, still in force, and new claims 8 and 9 outside the scope of any prior art

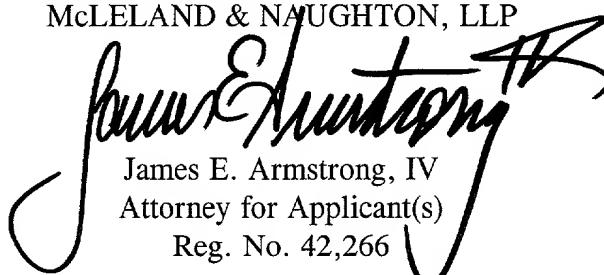
cited in the parent patent US Pat. No. 5,216, 135.

If, for any reason, it is believed that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. The fees for such an extension or any other fees which may be due with respect to this paper, may be charged to Deposit Account No. 01-2340.

Respectfully submitted,

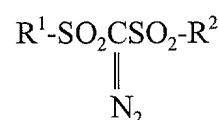
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VERSION WITH MARKINGS SHOWING CHANGES

7. (Amended) [The compound according to claim 4] A diazodisulfone compound of the formula:



wherein R¹ is a branched alkyl group having 3 to 8 carbon atoms; and R² is a cyclic alkyl group having 3 to 8 carbon atoms.